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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/519,151	03/06/2000	Manuel Zahariev	P3001D1	7821

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CENTRAL COAST PATENT AGENCY
PO BOX 187
AROMAS, CA 95004

EXAMINER	
DONAGHUE, LARRY D	

ART UNIT	PAPER NUMBER
2154	7

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicati n No. 09/519,151	Applicant(s) ZAHARIEV, MANUEL	
	Examiner Larry D Donaghue	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 December 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claims 1-18 ar presented for examination.

2. The rejection is maintained and set forth below.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1, 2, 5-6, 9-10, 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Pepe et al. (5,742,905).

Pepe et al. taught the invention (claim 1) as claimed, including a server (43) and a Mail Alert code , wherein the mail alert code is adapted to compare characteristics of the E-mail messages to specific characteristics prestored by the subscriber (col. 4, line 56- col. 5, line 9, col. 7, line 3-15) to alert the subscriber for forwarding the message (col. 34, lines 60-65; col. 4, lines 56-67).

5. Claims 5,9 and 13 fail to teach or define above or beyond claim 1, and are rejected for the reasons set forth above.

6. As to claims 2, 6, 10 and 15, Pepe et al. taught that the alert was sent to a pager (col. 5, lines 60-67). As to claim 14, Pepe et al. taught an alert mechanism (col. 34, lines 60-65; col. 4, lines 56-67).

7. As to claim 16, Pepe et al. taught a forwarding facility for retrieving and forwarding the message to destinations provided to the subscriber in response to the alert (col. 20, lines 42-53).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 4, 8, 12 and 18 are rejected under 35 U.S.C. 103(a) as applied to claims 1, 2, 5-6, 9-10, and 13-16 as being unpatentable over Pepe et al. (5,742,905).

10. Pepe et al. did not expressly disclose the use of the automated telephone menu for responding to the alert. Pepe et al. did disclose the use of a telephone menu (col. 11, lines 14-32) and Pepe et al. discloses the use of cross media notification and performing the redirection in realtime (col. 20, line 42 - col. 21, line 53). Pepe et al. taught that the system is for operating with mobile equipment such as PDA, pager and cellular phone (col. 5, lines 56-67). It would have been obvious to one of ordinary skill in the art at the time of the invention in view of the cited teachings that an automated telephone menu for responding to the alert would have been an obvious modification, as Pepe et al. expressly disclosed that the media and format for delivery is selectable by the subscriber (col. 6, lines 1-19).

11. Claims 3,7, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al. (5,742,905) as applied to claims 1, 2, 5-6, 9-10, and 13-16 above, and further in view of Fuller et al. (6,545,589).

Pepe et al. did not expressly disclose the involvement of an operator in the system, Fuller et al. taught the use of operator in a menu system to aid the user (col. 46, lines 12-30). It would have been obvious to one of ordinary skill in the data processing art at the time of the invention to allow for operator assists to aid the user in directing the calls.

12. Applicant's arguments filed 12/04/2003 have been fully considered but they are not persuasive.

In the remark applicant sets forth:

13. The Examiner has stated that Pepe teaches applicant's system for receiving and forwarding e-mail messages, including all of the subscriber's received e-mail messages with stored subscriber specified characteristics, and alerting the subscriber when a characteristic match is found. Applicant respectfully disagrees with the Examiner's interpretation of the teachings of Pepe, and argues that a prima facie rejection is clearly not supported by the teachings. Applicant's invention specifically teaches and claims alerting the subscriber that a characteristic match has been found between a received message and those provided by, and pre-stored by the subscriber. Pepe, in contrast, teaches sending alert notifications from servers to servers and from servers to subscribers, that a message has been received. Applicant now wishes to direct the Examiner's attention to applicant's specification beginning on page 4, line 22;, in ref rence to applicant's Figs. Ia-Ib. It is clearly described that a copy of a received message is retained on the server and the content of the message is then analyzed in order to determine whether a match between any characteristics of the message content exists with pr programmed stored characteristics provided by the subscriber.

When a match is found an alert is sent to the subscriber, the alert identified with an ID stamp, whereby the subscriber can request either a fax back or a forwarding of the specific message by phone using the id stamp, utilizing various known means.

14. In response, examiner disagrees as the step are expressly (col. 26, line 65 – col. 27, line 5) "For subject e-mail screening, the subject field is analyzed to determine if a match exists before comparing the address field. If the subject field matches an entry on the screening list, the treatment for a matched entry will occur. That means, in this illustrative embodiment, that subject screening takes precedence over address sender screening. That is, if e-mail originated from an address that is excluded from the e-mail screening address list, the e-mail will still be delivered according to the screening criteria. "

15. Pepe has no teaching of analyzing the content of the message to determine a characteristic match, and upon finding such a match, alerting the subscriber that a match has been found, as in applicant's invention. The body of the message may contain a great many additional characteristics in which to utilize for matching with stored characteristics supplied by the subscriber, thereby enhancing message screening and filtering capability and flexibility.

16. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (content of the body on the message) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

17. The Examiner has rejected claims 5, 9, and 13 for the reasons applied to claim 1. Claims 5 and 9 recite the specific limitations as argued above by applicant on behalf of claim 1, comparing characteristics of messages to specific stored characteristics provided by the subscriber, and alerting the subscriber when a characteristic match is found.

18. In response ,see the ¶14 and ¶16.

19. The Examiner has rejected claims 4, 8, 12 and 18 as being unpatentable over Pepe, and claims 3, 7, 12 and 17 as being unpatentable over Pepe and further in view of Fuller. As argued above by applicant, Pepe does not disclose or suggest comparing message characteristics of incoming messages to characteristics provided by, and stored on behalf of the subscriber, nor does Pepe teach alerting the subscriber that a characteristic match has been found.

20. In response ,see the ¶14 and ¶16.

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry D Donaghue whose telephone number is 703-305-9675. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 703-305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LARRY D. DONAGHUE
PRIMARY EXAMINER